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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,310	08/21/2001	G. David Jang	S63.2-10078	8078

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VIDAS, ARRETT & STEINKRAUS, P.A.  
6109 BLUE CIRCLE DRIVE  
SUITE 2000  
MINNETONKA, MN 55343-9185

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 04/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/934,310

Applicant(s)

JANG, G. DAVID

Examiner

Paul B. Prebilio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 34-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

***Information Disclosure Statement***

The information disclosure statement filed August 21, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and **all other information or that portion which caused it to be listed**. Because copies of the cited patent applications were not provided they have not been considered, but rather, they have been struck through.

In addition, one page of the PTO-1449 has not been considered because it was not legible; see the last page of the enclosed PTO-1449.

***Specification***

The disclosure is objected to because of the following informalities:

On page 1, the continuing data has not been updated with the current status of each parent application. Furthermore, the filing dates of the parent cases have not been provided. Finally, on the fifth line, the improper relationship of "continuation-on-part" is used.

On page 7, there is no brief description of Figure 6 and the description of Figures 6A and 6B does not appear to be accurate and correspond to the actual figure. Moreover, the brief description of Figure 9G is not correct because Figure 9G does not show a single connector strut.

The abstract is not drawn to the claimed invention because it makes not mention of a tapered configuration.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34 to 41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Particularly, both base claims suggest both a taper and a single diameter, but since the thickness of the stent wall is not disclosed as varying significantly, it is not clear how there can be a single diameter and a taper in the same device as disclosed. For this reason, the claimed invention is not enabled by the present specification, or alternatively, fails to have an adequate written description.

Claims 34-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Particularly, both base claims suggest both a taper and a single diameter, but since the thickness of the stent wall is not disclosed as varying significantly, it is not clear how there can be a single diameter and a taper in the same device as disclosed. For this reason, the claimed invention is not enabled by the present specification, or alternatively, fails to have an adequate written description.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Base claims 34 and 39 states that the stent has "a diameter throughout its length" yet dependent claims (claims 37 and 38, for example) suggest that there are multiple diameters along the length because of the taper. For this reason, it is unclear if a single diameter or multiple diameters are being set forth.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b):

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34, 35, 38, 39, and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25, 26, 73, and 74 of U.S. Patent No. 5,954,743. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are much

broader in scope such that they are read on by the patented claims. Since the difference of flexibility is inherent with shorter struts, the present claims are considered clearly obvious over the patented claims.

Claims 34, 35, 37-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30, 31, 35, and 37 of U.S. Patent No. 6,152,957. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are much broader in scope such that they are read on by the patented claims. Since the difference of flexibility is inherent with shorter struts, the present claims are considered clearly obvious over the patented claims.

Claims 34, 35, and 37-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 76, 77, 81, 83, and 85 of U.S. Patent No. 5,922,021. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are much broader in scope such that they are read on by the patented claims. Since the difference of flexibility is inherent with shorter struts, the present claims are considered clearly obvious over the patented claims.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 36 and 41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Roubin (US 6,106,548).

With regard to claims 36 and 41, upon review of the parent applications, it was determined that claims 36 and 41 have an effective filing date of no earlier than March 25, 1997. Claims 34, 35, and 37-40 have an effective filing date of April 26, 1996. For this reason, Roubin constitutes prior art with respect to claims 36 and 41.

Roubin anticipates the claims where the struts as claimed are the V-shaped elements of Roubin which can be thickened to make them more rigid; see column 8, lines 30-52 as well as Figure 11 and claims 8 and 12 of Roubin.

Claims 34, 35, 36, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinchuk (US 5,575,818). Pinchuk anticipates the claim language where the claimed tapered configuration and plurality of annular elements as shown in Figures 5 and 7. The locking ring end (514) has a greater radial force or is less flexible due to the higher braid angle; see column 4, lines 24-65.

With regard to claim 36, by inspection of the drawings (Figures 5 and 7), it is clear that the struts between crossover points of the braid have the same length in each section; only the angle of the struts varies.

Claims 34-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Hankh et al (US 5,922,019) wherein the first larger end of Hankh has less flexibility or a greater radial force than the second end; see Figure 1 and column 2, lines 39-65. The struts of the stent are all the same length by inspection of the drawings; see Figure 3C.

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With regard to claim 38, Applicant is directed to see Figure 3 of Hankh where the section (29) varies continuously from the first section to the second section.

Claims 34-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Porter (US 5,064,435) wherein either coaxial segment (20) or (22) reads on the claimed invention; see Figure 1. The flared end would inherently have a higher flexibility because of its same braid angle but larger diameter.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
Art Unit 3738